

Serial No.: 09/268,412

The present invention is directed to decorating shoes, such as sports shoes or children's shoes, and is specifically concerned with decorating a shoe with stick-on tattoos. It is quite common for manufacturers to include various decorative designs on the shoes that they manufacture. Unfortunately, most such designs are permanently printed or sewn onto the shoe. As a result, in order to display a different design, a customer typically must purchase a different shoe bearing the desired design. Clearly, this can be costly and often impractical.

Responding to the problem, various approaches have been proposed to provide shoes having decorations that can be customized by the end user. In one, adhesive-backed stickers are applied to a shoe. Unfortunately, such stickers usually cannot be easily removed from the shoe, thus often resulting in a permanent decoration of the shoe once applied. In addition, the adhesive used on such stickers may even damage the shoe.

The present invention addresses the foregoing problems by providing a shoe decorating technique and a decorated shoe in which a stick-on tattoo that does not include separate adhesive material is applied to a smooth outer surface of the shoe. See Figure 2, reference number 102; page 7, lines 12 to 15; and page 7, lines 20 to 21, of the Specification. By using such a stick-on tattoo as the decorative article and by applying the tattoo to a smooth outer portion of the shoe in this manner, the present invention allows a shoe to be decorated and re-decorated with relatively little effort,

Serial No.: 09/268,412

while typically ensuring that the decorative article remains on the shoe until it is desired to be removed.

It is noted that a variety of "stick-on tattoos" are available commercially. Some, such as those described in Creative Crystal, use adhesive backing and therefore are simply one type of what is commonly known as a sticker. Another class of stick-on tattoos, those used in the present invention, do not rely upon separate adhesive backing. These types of tattoos typically adhere by taking advantage of the different properties that the tattoo material exhibits when wet, as compared with the material's dry state. Because no adhesive is used, the types of materials to which such tattoos will reliably adhere often is much more limited than is the case with adhesive-backed tattoos. Moreover, of those materials to which such non-adhesive tattoos will so adhere, the number of materials from which such tattoos may be removed with relative ease when desired is even more limited. As a result, the conventional use of such non-adhesive-backed tattoos mainly has been limited to application to skin.

Nevertheless, Applicant has discovered that such a non-adhesive-backed tattoo can be effectively applied to a shoe and then later relatively easily removed if a sufficiently smooth surface is provided. At the same time, any potentially damaging or toxic effects of using a tattoo having separate adhesive material can be avoided.

In the present invention, the smooth surface to which the stick-on tattoo is attached preferably is comprised of polyvinyl chloride or other type of smooth plastic (page 5, lines 17 to 19), but in any event more preferably allows the stick-on tattoo to

Serial No.: 09/268,412

be removed with no more than moderate effort by only scratching with a fingernail, even after adhering to the shoe for more than one month (page 8, lines 4 to 8). In other aspects of the invention, the smooth surface to which the stick-on tattoo is applied is either clear or white (page 5, lines 21 to 23), thereby allowing better visibility of the stick-on tattoo.

Thus, independent claim 1 is directed to decorating a shoe by wetting a stick-on tattoo and applying the stick-on tattoo to a smooth outer surface of the shoe, in which the stick-on tattoo does not include separate adhesive material and is applied to the shoe without using separate adhesive material. Independent claim 11 is directed to a decorated shoe having a stick-on tattoo attached to a smooth portion of the outer surface of the shoe, in which the stick-on tattoo does not include separate adhesive material and adheres to the shoe without use of separate adhesive material.

The applied art does not disclose or suggest the foregoing combinations of features. In particular, the applied art does not disclose or suggest at least the feature of a stick-on tattoo that does not include separate adhesive material adhering to a smooth outer surface of a shoe without the use of separate adhesive material.

To the contrary, the "tattoos" sold by Creative Crystals are "backed with a medical adhesive specially formulated for use on human skin". This fact is stated in another Web page of the Web site from which the Creative Crystals reference was taken. A copy of this additional Web page previously was provided to the Examiner, and a copy is attached as Appendix A hereto.

Serial No.: 09/268,412

Thus, while the Creative Crystals reference discloses attaching its tattoos to a shoe, this disclosure is nothing more than the prior art technique of using adhesive-backed stickers on a shoe. As noted above, such adhesive-backed stickers often are difficult to remove and attempts at removal frequently end up damaging the shoe. Therefore, such adhesive-backed stickers are inappropriate where removal and/or redecorating is desired.

In the Office Action, it is asserted that Creative Crystals teaches the application of artificial tattoos for the purposes of decoration, and that this teaching would have motivated one skilled in the art to apply a SkinWear tattoo to a shoe. However, the mere fact that Creative Crystals calls its adhesive-backed decorative articles "tattoos" does not alter the fact that they are fundamentally different, and have significantly different applicability, than the tattoos recited in the present claims. As recited above, the tattoos of the present invention do not include separate adhesive material and adhere to a shoe without using separate adhesive material.

While adhesive-backed stickers can adhere to almost any surface, the same is not true of the tattoos of the present invention. To emphasize this point, a declaration of the inventor in this case is submitted as Appendix B hereto (the Inventor's Declaration). The inapplicability of non-adhesive-backed tattoos is shown in paragraph 3 of the Inventor's Declaration. In that paragraph, the inventor states that his experiments proved that a non-adhesive-backed tattoo rarely will adhere to a conventional shoe.

Serial No.: 09/268,412

Only after a significant amount of effort did the inventor realize that the solution to this problem was to apply tattoos such as the SkinWear brand to a smooth surface of the shoe. In paragraph 5, the inventor further notes that very few conventional shoes have such a smooth surface.

As a result, it is not believed that any use of the type of sticker advertised in Creative Crystal would have prompted one skilled in the art to make any use at all of the type of stick-on tattoo recited in the present claims. In fact, because Creative Crystal is advertising its own items, it must be inferred that the sole purpose of that reference is to promote those items over any possible alternatives.

In addition, the Creative Crystal product consists solely of adhesive-backed crystal rhinestones, allowing the user to create rhinestone patterns on many different types of surfaces. Thus, the main, if not sole, teaching of Creative Crystal is to apply rhinestones as decorations to the wearer's skin or clothing. By contrast, the tattoo of the present invention does not include separate adhesive material and adheres to a shoe without using separate adhesive material. As a result, the tattoo used in the present invention typically will consist of a flat piece of material which would not be ideally suited to application of rhinestones. That is, even if the weight of a few rhinestones could be embedded in such a material in a manner that would permit them to be supported by a tattoo of the present invention (i.e., without adding undue weight which would prevent the tattoo from adhering): (i) it seems unlikely that one could obtain the rhinestone density to achieve the types of patterns illustrated in Creative

Serial No.: 09/268,412

Crystal; and (ii) in any event, the rhinestones still would have to be embedded in the tattoo itself, thereby eliminating the nice aesthetic effect of rhinestone against skin, clothing or shoes that is achieved through use of the Creative Crystal product.

Based on these significant differences, it is not believed that one of ordinary skill in the art with knowledge of Creative Crystal would have been motivated to use the non-adhesive backed tattoos of the present invention in any manner whatsoever, much less to apply them specifically to shoes.

The requirements for establishing a *prima facie* case for a § 103 rejection have been stated as follows:

“a proper analysis under § 103 requires, inter alia, consideration of two factors: (1) whether the prior art would have suggested to those of ordinary skill in the art that they should make the claimed composition or device, or carry out the claimed process; and (2) whether the prior art would also have revealed that in so making or carrying out, those of ordinary skill would have a reasonable expectation of success. [citing In re Dow Chemical Co., 837 F.2d 469, 473, 5 U.S.P.Q.2D 1529, 1531 (Fed. Cir. 1988).] Both the suggestion and the reasonable expectation of success must be found in the prior art, not in the applicant's disclosure.”

In re Vaeck, 947 F.2d 488, 493 (Fed. Cir. 1991).

As discussed above, it is not believed that the mere facts that Creative Crystal calls its adhesive-backed decorative items “tattoos” and discusses applying them to shoes would have motivated one skilled in the art to apply a tattoo of the type used in the present invention to a shoe. Similarly, nothing in Creative Crystal or in SkinWear teaches or suggests seeking out a smooth surface of a shoe for applying such a tattoo. Thus, factor (1) above is not believed to be satisfied.

Serial No.: 09/268,412

In addition, clearly nothing in Creative Crystal reveals that attempting to apply a stick-on tattoo that does not include separate adhesive material to a conventional shoe would have been successful. On the other hand, the submitted Inventor's Declaration strongly suggests that it would not be. SkinWear itself has been reviewed in detail and is only seen to teach application of such tattoos to skin. Accordingly, factor (2) also is not believed to be satisfied.

Lacking both factors of the test, it is not believed that any permissible combination of Creative Crystal and SkinWear could have rendered independent claims 1 or 11 obvious. Claims 1 and 11 are therefore believed to be allowable over the applied art.

Claims 4 and 15 depend from claims 1 and 11, respectively, and recite the further limitation that the smooth portion of the outer surface of the shoe is comprised of polyvinyl chloride (PVC). This limitation is not disclosed or suggested by the applied art.

At the outset, it is noted that very few shoes have outer surfaces comprised of PVC. Therefore, without some specific motivation, it is not believed that one would seek out a PVC surface for application of stick-on tattoos. In this regard, Creative Crystal does not appear to be very particular about the surfaces to which its decorative items are applied. This most likely is because Creative Crystal's use of a medical adhesive will permit such items to be applied to a wide variety of surfaces. In any event, Creative Crystal certainly does not suggest applying its decorative items to an

Serial No.: 09/268,412

outer surface of a shoe comprised of PVC. SkinWear only mentions application of its tattoos to skin and therefore also says anything at all about application of stick-on tattoos to a PVC surface of a shoe. Thus, it is believed that none of the applied art, either alone or in combination would have disclosed or suggested this feature of the invention.

In the Office Action, it is asserted that use of a PVC surface on a shoe is common, and therefore it would have been obvious to apply tattoos as recited in the present claims to such a surface. However, Applicant disagrees with this assertion, and the Office Action has not cited any prior art that would show that use of a PVC surface on a shoe was common at the time of the present invention.

With respect to this assertion in the Office Action, it is noted that MPEP § 2142 requires that in order to establish a *prima facie* case of obviousness, the Examiner must cite prior art references that teach or suggest all of the claim limitations and, if more than one such reference is required to disclose all such limitations, there must be some suggestion or motivation, either in the prior art references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine the reference teachings. However, no such evidence that PVC surfaces were common on shoes at the time of the present invention.

Absent such a showing, it cannot be said that applying the tattoos of the present invention to such a surface (particularly when they do not adhere to most other types of shoe surfaces) would have been an obvious alternative or a matter of design choice, as



Serial No.: 09/268,412

asserted in the Office Action. It is therefore believed that a *prima facie* case of obviousness has not been made out with respect to claims 4 and 15.

For these additional reasons, claims 4 and 15 are believed to be allowable over the applied art.

Claim 5 recites the further limitation that the stick-on tattoo is removed from the shoe and a second stick-on tattoo is applied to the shoe. With regard to this limitation, the Office Action merely asserts that this would have been obvious and well within the ordinary skill of the ordinary skilled worker if the first tattoo is desired to be replaced. However, as shown in paragraph 4 of the Inventor's Declaration, once a tattoo of the present invention adheres to a conventional shoe it is usually very difficult to remove it from the shoe without damaging the shoe. Thus, when applying such a tattoo to a conventional shoe there would have been no practical motivation to subsequently remove it and apply another. Only through the present invention's use of a smooth surface of a shoe is this impediment overcome. However, there is no teaching or suggestion in the prior art that one should seek out such a smooth surface in order to facilitate removal of a tattoo and application of a replacement. For these additional reasons, claim 5 is believed to be allowable over the applied art.

Claim 6 recites the further limitation that the stick-on tattoo is applied to a portion of the outer surface of the shoe that is white. This feature of the invention is not disclosed or suggested by the applied art. In this regard, the Office Action simply asserts that smooth white surfaces are common on shoes and therefore this feature of

Serial No.: 09/268,412

the invention would have been an obvious alternative or a matter of design choice.

However, Applicant disagrees with the assertion that smooth white surfaces are common on shoes, and no reference has been cited to show that such surfaces are common. Rather, Applicant believes that such surfaces are uncommon and one would have had to seek out such a surface. However, the prior art provides no motivation to do so. Instead, that motivation is only present in Applicant's own patent application specification, which of course cannot provide the grounds for an obviousness rejection. For these additional reasons, claim 6 is believed to be allowable over the applied art.

Claim 7 recites the further limitation that the stick-on tattoo is applied to a portion of the outer surface of the shoe that is clear. This feature of the invention is not disclosed or suggested by the applied art. In this regard, the Office Action simply asserts that smooth clear surfaces are common on shoes and therefore this feature of the invention would have been an obvious alternative or a matter of design choice. However, Applicant disagrees with the assertion that smooth clear surfaces are common on shoes, and no reference has been cited to show that such surfaces are common. Rather, Applicant believes that such surfaces are uncommon and one would have had to seek out such a surface. However, the prior art provides no motivation to do so. Instead, that motivation is only present in Applicant's own patent application specification, which of course cannot provide the grounds for an obviousness rejection. For these additional reasons, claim 7 is believed to be allowable over the applied art.

Serial No.: 09/268,412

Claim 8 recites the further limitation that the stick-on tattoo can be removed with no more than moderate effort by only scratching with a fingernail even after adhering to the shoe for more than one month. The Office Action asserts that this limitation would have been inherent in or obvious from the use of the SkinWear tattoo. However, as shown in paragraph 4 of the Inventor's Declaration, once a tattoo of the present invention adheres to a conventional shoe it is usually very difficult to remove it from the shoe without damaging the shoe. Thus, removal of a tattoo as recited in claim 8 would not generally have when possible when the tattoo was applied to a conventional shoe. Only through the present invention's use of a smooth surface of a shoe is this limitation made possible. However, there is no teaching or suggestion in the prior art that one should seek out such a smooth surface in order to facilitate removal of a tattoo and application of a replacement. For these additional reasons, claim 8 is believed to be allowable over the applied art.

Claim 17 depends from independent claim 11 and recites the further limitation that the smooth portion of the outer surface of the shoe approximately matches the stick-on tattoo in size. This feature is not disclosed or suggested by the applied art. Instead, the Office Action merely concludes that such a feature would be an obvious matter of design choice well within the skill of the ordinary skilled worker if so desired. However, no prior art reference has been cited in the Office Action to support this assertion. As a result, it is believed that a *prima facie* case has not been made out with respect to this claim.

Serial No.: 09/268,412

For this additional reason, claim 17 is believed to be allowable over the applied art.

Newly added dependent claims 21 and 22 depend from claims 1 and 11, respectively, and recite the further limitation that the smooth portion of the outer surface of the shoe is comprised of plastic. This limitation is not disclosed or suggested by the applied art.

At the outset, it is noted that very few shoes have outer surfaces comprised of plastic. Therefore, without some specific motivation, it is not believed that one would seek out a plastic surface for application of stick-on tattoos. In this regard, Creative Crystal does not appear to be very particular about the surfaces to which its decorative items are applied. This most likely is because Creative Crystal's use of a medical adhesive will permit such items to be applied to a wide variety of surfaces. In any event, Creative Crystal certainly does not suggest applying its decorative items to an outer surface of a shoe comprised of plastic. SkinWear only mentions application of its tattoos to skin and therefore also says anything at all about application of stick-on tattoos to a plastic surface of a shoe. Thus, it is believed that none of the applied art, either alone or in combination would have disclosed or suggested this feature of the invention.

For these additional reasons, claims 21 and 22 are believed to be allowable over the applied art.

Serial No.: 09/268,412

The other rejected claims in this application depend from the independent claims discussed above, and are therefore believed to be allowable for at least the same reasons. Because each dependent claim also defines an additional aspect of the invention, however, the individual reconsideration of each on its own merits is respectfully requested.

In view of the foregoing remarks, it is believed that the entire application is in condition for allowance. An indication to that effect therefore is respectfully requested.

Serial No.: 09/268,412

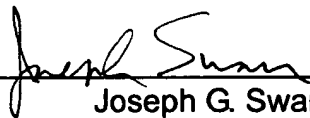
If there are any fees due in connection with the filing of this paper that have not been accounted for in this paper or the accompanying papers, please charge the fees to our Deposit Account No. 13-3735. If an extension of time under 37 C.F.R. 1.136 is required for the filing of this paper and is not accounted for in this paper or the accompanying papers, such an extension is requested and the fee (or any underpayment thereof) should also be charged to our Deposit Account. A duplicate copy of this page is enclosed for that purpose.

Respectfully submitted,

**MITCHELL, SILBERBERG & KNUPP LLP**

Dated: August 22, 2002

By



Joseph G. Swan  
Registration No. 41,338

**MITCHELL, SILBERBERG & KNUPP LLP**  
11377 West Olympic Boulevard  
Los Angeles, California 90064  
Telephone: (310) 312-2000  
Facsimile: (310) 312-3100



COPY OF PAPERS  
ORIGINALLY FILED

---

## Appendix "A"

# Creative Crystal™

Austrian Crystal Iron-On Rhinestones, Pearls & Metal Trims

[HOME](#) | [SHOP](#) | [HELP](#) | [SEARCH](#)



*The original Swarovski Austrian  
crystal rhinestone tattoo  
For Skin, Fabrics and Accessories*



**SCROLL HERE TO GO SHOPPING**



Named the "hottest new fashion item" at the Cannes Film Festival 2000. Worn by movie stars, recording artists, models and now available to you! Designed specifically for use on skin, tattoos also can be used as a temporary embellishment on fabrics, accessories and home decor.

The perfect temporary tattoo. Made with Swarovski® 10ss clear crystal rhinestones backed with a medical adhesive specially formulated for use on human skin. Simply peel off the white protective film and place the tattoo on skin or item to be decorated. Complete directions included. Available in the most popular designs.

## Creative Tattoo Ideas!

### VIEW COMPLETE SELECTION & PURCHASE

**NEW !** Huge price reduction in progress !

Wholesale customers please register at our [NEW wholesale site](#) or e-mail us now for details on products for your store.  
Excellent product with fantastic potential.

Email: [tattoos@creative-crystal.com](mailto:tattoos@creative-crystal.com)

**THE PERFECT GIFT  
FOR THAT SPECIAL  
SOMEONE  
Holiday and Gift  
Packaging now  
available**

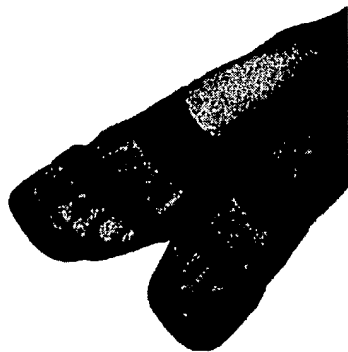
**RECEIVED**  
AUG 30 2002  
TECHNOLOGY CENTER R3700





### GIFT BOXED TATTOOS

We will package your choice of tattoo (or kit) in a gloss white, embossed jewelry box with gold seal and elastic tie with bow. Includes alcohol wipe. Choose gift package option below your choice of tattoo(s).



Designer shoes with rhinestones \$180 and up - Your shoes trimmed with Crystal Tattoos less than \$12.00. Use Line Tattoos for anklets, toe rings, bracelets, armbands and much more. Click below for more ideas.

### Creative Tattoo Ideas



Clean skin thoroughly with soap and water, then dry. For longest wear, clean skin with alcohol and dry. Carefully remove white plastic backing and discard. Tattoo will be held in place on clear film.



Place tattoo on clear, dry skin or item to be decorated. Allow to "warm" for approximately 10 seconds.



Slowly peel off clear film - replace backing and press again if any stones are not firmly on skin.

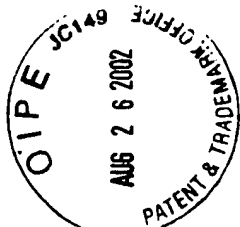


Your tattoo can be easily removed from skin (do not wear for more than 2 days. Rhinestones are held in place by a special medical adhesive



The hot look this year! Rhinestone sunglasses- Designer version \$450 and up - Your glasses trimmed with Creative Crystal Line Tattoos less than \$12.00

RECEIVED  
AUG 30 2002  
TECHNOLOGY CENTER R3700



**CLICK HERE TO PURCHASE TATTOOS.**

Wholesale customers e-mail us now for details on products for your store. Excellent product with fantastic potential.

Email: [tattoos@creative-crystal.com](mailto:tattoos@creative-crystal.com)

**Creative Crystal Company**

**6222 Tower Lane - Suite B-7 • Sarasota, FL 34240**

**Sales 1.800.578.0716 • Customer Service 1.941.377.5008**

**FAX 1.941.377.8047 • E-mail: [crystal@creative-crystal.com](mailto:crystal@creative-crystal.com)**

All materials © 1997-2002 Creative Crystal™ Co. (div. Haute Mode, Inc.)

Any reproduction without the written express permission of Creative Crystal™ Company is strictly prohibited.

COPY OF PAPERS  
ORIGINALLY FILED

RECEIVED  
AUG 30 2002  
TECHNOLOGY CENTER R3700

COPY OF PAPERS  
ORIGINALLY FILED

---



## Appendix "B"

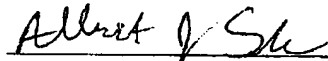
COPY OF PAPERS  
ORIGINALLY FILED

## Declaration of Inventor Traversing Rejection

I, Albert J. Silvera, hereby declare as follows:

1. I am the inventor under U.S. Patent Application Serial No. 09/268,412, filed on March 15, 1999, titled "Technique for Decorating a Shoe and a Shoe Decorated Using the Technique".
2. Prior to my conception of the present invention, I conceived the idea of applying non-adhesive-backed tattoos to shoes as a technique for decorating and re-decorating shoes. I therefore began experimenting using SkinWear brand temporary tattoos, which are comprised of a film-like material that includes a combination of a copolymer and a polyester resin.
3. Upon experimentation, I discovered that attempts to apply non-adhesive-backed tattoos to conventional shoes usually failed. More specifically, I discovered that such tattoos rarely adhered to conventional shoes.
4. In addition, in the rare cases when I was able to get a non-adhesive-backed tattoo to adhere to a shoe it was usually very difficult to remove it from the shoe without damaging the shoe. This was a particular problem when the tattoo had been on the shoe for a long period of time.
5. After more experimentation with different types of materials and under different conditions, and also after studying the problem further, I discovered that the key to providing good adhesion while permitting relatively easy removal was to use a smooth surface. In this regard, upon close inspection it will be observed that most conventional shoes have significant surface roughness and/or irregularities, even when appearing smooth to the naked eye or feeling smooth to the touch.
6. I discovered that a good material for overcoming the aforementioned problems is a smooth polyvinyl chloride (PVC) or other smooth plastic. A shoe having a smooth PVC piece stitched onto its outer surface was constructed for testing. The non-adhesive backed tattoo applied easily to the PVC portion of the outer surface of the shoe. Then, even after a long period of time, such as more than a month, the tattoo could be removed with only moderate effort by scraping with a fingernail or by washing with water alone or water in combination with soap.
7. Still further experimentation showed that the colors of most non-adhesive-backed tattoos showed best against a clear or white background.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

  
Albert J. Silvera

August 20, 2002

Serial No.: 09/268,412



If there are any fees due in connection with the filing of this paper that have not been accounted for in this paper or the accompanying papers, please charge the fees to our Deposit Account No. 13-3735. If an extension of time under 37 C.F.R. 1.136 is required for the filing of this paper and is not accounted for in this paper or the accompanying papers, such an extension is requested and the fee (or any underpayment thereof) should also be charged to our Deposit Account. A duplicate copy of this page is enclosed for that purpose.

RECEIVED

AUG 30 2002

Respectfully submitted,

MITCHELL, SILBERBERG & KNUPP LLP

TECHNOLOGY CENTER R3700

Dated: August 22, 2002

By

A handwritten signature in black ink, appearing to read "Joseph G. Swan", written over a horizontal line.

Joseph G. Swan

Registration No. 41,338

MITCHELL, SILBERBERG & KNUPP LLP  
11377 West Olympic Boulevard  
Los Angeles, California 90064  
Telephone: (310) 312-2000  
Facsimile: (310) 312-3100